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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,634	03/15/2002	Michael P. Whitman	11443/72	4140
26646	7590	10/02/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/099,634

Applicant(s)

WHITMAN ET AL.

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16, 19-21 and 37-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 19-21 and 40-49 is/are rejected.
- 7) ☒ Claim(s) 37-39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

- [01] A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/21/2006 has been entered.

### **Specification**

- [02] The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### **Claim Rejections - 35 USC § 102**

- [03] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [04] Claims 1-3 & 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuma (6,547,721).
- [05] In regard to claims 1-3 & 40-44, Higuma et al. teach an endoscope 1 comprised of an insertion unit 2, an operation unit 3 and a universal cord 4 (see Figure 1). Insertion unit 2 has a bendable part 9 having bending pieces 32 that actuate to bend the bendable part 9 via actuation of bending lever 11 (see Figure 3). An armor tube 35 made of a polymeric material, such a fluorine-contained rubber,

surrounds the insertion unit 2 and bendable part 9 (see Figure 3 and col. 8, lines 10-14). Higuma et al. also teach a moisture absorptive member 158 that, as broadly as claimed, constitutes a moisture sensor disposed within the armor tube 35 to detect moisture. As Higuma et al. disclose that moisture absorptive member may be removed (see col. 26, lines 1-2), it follows that its appearance would communicate the presence of moisture (indicating the need for removal and replacement).

- [06] Anything that communicates the presence of moisture inherently communicates data corresponding to the presence of moisture. The shaft of Higuma may be considered flexible, or alternatively, rigid and articulable.

#### **Claim Rejections - 35 USC § 103**

- [07] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [08] Claims 7-9, 11-16, 19 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuma et al. (U.S. Patent No. 6,547,721) in view of Ishikawa et al. (U.S. Patent No. 6,071,233).
- [09] In regard to claims 11-13 and 19, see the above rejections for claims 1-3. With further respect to claim 11 and in regard to claims 7-9 and 14-16, Higuma et al. are silent as to a coupling including a locking mechanism that attaches to armor tube 35. However, Ishikawa et al. disclose a channel tube 2 that is coupled to an endoscope to allow the passage of instruments via a fixing tape 42 (see Figures

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3A and 3B). Higuma et al. thus demonstrate that channel tube 2 that detachably couple to the exterior of an endoscope via a flexible strip locking mechanism are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the endoscope 1 of Higuma et al. with the channel tube 2 and flexible tape 42 of Ishikawa et al. as a means to attach an additional tool tube to the exterior of the endoscope.

### **Additional Claim Rejections - 35 USC § 103**

[10] Claims 4-6, 20-21, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuma et al. (U.S. Patent No. 6,547,721) in view of Ishikawa et al. (U.S. Patent No. 6,071,233), as set forth above, and further in view of Abe (U.S. Patent No. 6,669,628).

[11] Iguma et al. and Ishikawa et al. are silent as to a memory unit disposed on the endoscope 1. However, Abe discloses an endoscope having a memory 33 for storing data (see col. 3, lines 25-32). Abe thus demonstrates that endoscopes having the ability to store data are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the endoscope of Higuma et al. with the memory 33 disclosed by Abe. A skilled artisan would be motivated to do so in order to enable the storage of image or calibration data relevant to the patient or endoscope, as is well-known in the art.

### **Allowable Subject Matter**

[12] Claims 37-39 are allowed.

### **Response to Arguments**

[13] Applicant's arguments filed 7/21/2006 have been fully considered but they are not persuasive. Applicant contends that "Higuma et al. do not describe a moisture sensor disposed within the outer sheath configured to communicate data corresponding to the presence of moisture as recited in claim 1." As stated in the Office action of 1/23/2006, the moisture sensor disclosed by Higuma does communicate the presence of moisture; communication inherently requires "data" - whatever is communicated is and must be considered data. Data is defined as "factual information (as measurements or statistics) used as a basis for reasoning, discussion, or calculation." The presence of moisture is indubitably communicated by the moisture absorber disclosed by Higuma; it is recommended that the detected moisture be used as a basis for replacing the absorber.

[14] Applicant further contends that "the presence of moisture in Higuma et al. is at most indicated by an inspection by a user of the moisture absorptive member 158 when removed." This characterization of Higuma's invention suffices to anticipate claim 1, as broadly interpreted.

[15] Applicant further contends that the references used to modify Higuma do not disclose the "data" referred to above. This argument is convincing, but does not change the standing of the claims.

### **Conclusion**

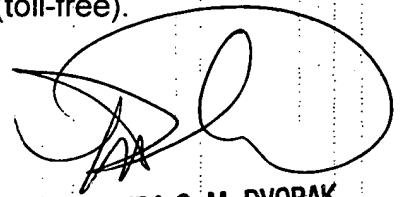
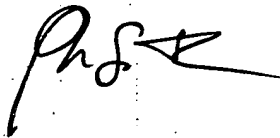
[16] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571)

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272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.

[17] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.

[18] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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